REMARKS

By this Amendment, Applicants amend claims 1, 18, 20, and 21, and cancel claims 16 and 19 without prejudice or disclaimer of the subject matter thereof. Claims 1-16, 18-21, and 23 remain pending in this application.

In the Office Action,[1] the Examiner alleged that the Declaration is defective and rejected claims 1-16, 18-21, and 23 under 35 U.S.C. § 103(a) as being unpatentable over Hsu (U.S. Patent No. 5,631,790) in view of Hancock et al. (U.S. Patent No. 6,202,023).

I. CONSIDERATION OF INFORMATION DISCLOSURE STATEMENTS

As an initial matter, although the Examiner acknowledged in the present Office Action that the Information Disclosure Statement (IDS) filed on October 7, 2005, was being considered, Applicants point out that the Examiner did not return an initialed copy of the Form PTO SB/08. Furthermore, during a telephone conversation on January 12, 2006, Applicants' representative informed the Examiner of an additional IDS that was filed on December 12, 2005. However, the Examiner has also not returned an initialed copy of the Form PTO SB/08 that accompanied the IDS of December 12, 2005.

As the IDSs comply with all pertinent regulations, Applicants request that the Examiner return initialed copies of the forms with the next Office communication.

[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Applicants attach copies of both Decisions for the Examiner's convenience. In view of the Decisions, Applicants submit that the Declaration is, in fact, not defective and request that the Examiner withdraw the objection to the Declaration.

III. REJECTION OF CLAIMS 1-16, 18-21, AND 23 UNDER § 103(a)

Applicants respectfully traverse the rejection of claims 1-16, 18-21, and 23 under 35 U.S.C. § 103(a) as being unpatentable over Hsu in view of Hancock. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. *See* M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. *See* M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. *See* M.P.E.P. § 2143 (8th ed. 2001).

Claim 1 recites a system for automatically annotating a second map when a first map is annotated including, among other things, "a map processing platform" to "receive a user annotation at a first location on the first map expressed by first map coordinates," and "display the user annotation on the second map at the second map coordinates." Hsu and Hancock, whether taken individually or in combination, do not disclose or suggest at least these elements of claim 1.

The Examiner contends that FIG. 2 of Hsu "illustrates five different layers ... [which are] geographically similar to each other" and that FIG. 2 meets the preamble of a "system for automatically annotating a second map when a first map is annotated." See Office Action, page 3. Applicants disagree. FIG. 2 of Hsu shows a Geographical Information System (GIS) data dictionary. "A data dictionary is a list that maintains, for each coverage, the names of attributes (e.g., size, shape, texture, intensity, location, etc.) and a description of attribute values." See col. 4, lines 20-27. Applicants submit that the "data dictionary" of Hsu, which is merely a collection of metadata describing attributes of a polygon, does not disclose or suggest Applicants' claimed map processing platform, which is adapted to "receive a *user annotation* at a first location on the first map expressed by first map coordinates," and "display the *user annotation* on the second map at the second map coordinates," as required by claim 1. Accordingly, the Examiner has not shown that Hsu teaches or suggests receiving a "user annotation" on a first map or receiving a "user annotation" on a second map, as required by claim 1.

The Examiner also contends that FIG. 3, step 104 of Hsu teaches aspects of Applicant's claimed invention. Applicants again disagree. As taught by Hsu, "level 1 preprocessor 104 is used to convert vector data to image (raster) data, to correct geometric and spectral errors, to perform resolution matching, to zoom, rotate and scale (so as to align the separate images with one another), and to filter and transform images, if necessary." See col. 9, lines 32-37. While Hsu teaches that vector data is converted to image data, Hsu does not teach or suggest Applicants' claimed map processing platform, which is adapted to "receive a *user annotation* at a first location on the first map expressed by first map coordinates," and "display the *user annotation* on

the second map at the second map coordinates," as required by claim 1. Rather, the Examiner has not demonstrated any teaching or suggestion in Hsu of a user annotation that is received on a first map and then displayed on a second map.

The Examiner also contends that since Hsu "implements several layers of information similar to fig. 3, then if a person manipulates an area in one of the layers or maps, the corresponding coordinates would be in the same area associated with [the] manipulated layer, i.e. similar to what claim invention claims." See Office Action, page 4. The Examiner appears to equate combining or overlaying layers of data with the elements recited in claim 1. The Examiner alleges "if a person manipulates an area in one of the layers or maps," it would be similar to what Applicants' claim. Even if the Examiner's allegation were correct, which Applicants do not concede, there is no teaching or suggestion in Hsu that any such manipulation occurs. The Examiner's speculation regarding what might happen is inappropriate because there is no teaching or suggestion in the Hsu reference for receiving and displaying a user annotation. Rather, Hsu teaches integrating objects from multiple image sources, i.e., maps, but does not teach user annotations. See col. 2, lines 34-46. Thus, Hsu does not teach or suggest Applicants' claimed map processing platform, which is adapted to "receive a *user annotation* at a first location on the first map expressed by first map coordinates," and "display the *user annotation* on the second map at the second map coordinates," as required by claim 1.

Applicants also point out that the Hsu system requires "preprocessing" for "raw" images. See col. 9, lines 32-33. For example, "[t]he level 1 preprocessor 104 is used to ... zoom, rotate and scale (so as to align the separate images with one another), and to

filter and transform images, if necessary." See col. 9, lines 33-37. According to Hsu, images, such as the various layers shown in FIG. 2, are adjusted and aligned prior to processing. As shown in FIG. 2, the layers are overlaid one on top of the other. However, if the layers are not aligned prior to being overlaid, then the combined layers would incorrectly map features on the layers to the wrong locations. Accordingly, Hsu teaches away from the present invention because it requires the layers to be aligned prior to processing. Applicants' claim 1, however, recites a "system for automatically annotating a second map when a first map is annotated, the second map being geographically substantially similar to the first map," but does not require that the maps be aligned prior to processing.

Moreover, claim 1 also requires that the map processing platform is adapted to "convert from the first map coordinates to *corresponding* geographic coordinates using a georeferencing function of the first map" and "convert from the geographic coordinates to *corresponding* second map coordinates using a georeferencing function of the second map" (emphasis added). The Examiner alleges that Hsu teaches these elements. Applicants again disagree.

By contrast, the Hsu system "accepts multiple data sources 100 for one common geographic area. The sources can be existing maps, geocoded, socio-economic data such as census tracks, and various images such as LANDSAT or SPOT satellite imagery." See col. 8, lines 54-61. Further, once the incoming data is received, "the goal of preprocessing is to transform the incoming observed data into a format in which objects are readily extractable." See col. 9, lines 27-31. "If images are properly aligned, however, preprocessing levels 1 and 2 need not be performed at all. If the images are

"raw" ... preprocessing is required." See col. 9, lines 29-33. As taught by Hsu, "level 1 preprocessor 104 is used to convert vector data to image (raster) data," among other purposes. However, converting vector data to image data does not constitute or suggest "convert[ing] from *the* first map coordinates to *corresponding* geographic coordinates using a georeferencing function of the first map" and "convert[ing] from *the* geographic coordinates to *corresponding* second map coordinates using a georeferencing function of the second map," as required by claim 1 (emphasis added).

Applicants note that the claimed "first map coordinates" are converted to geographic coordinates and are located at the user annotation received at the first location on the first map. Applicants further note that the claimed "geographic coordinates" are converted to *corresponding* second map coordinates of the second map. For example, as recited in claim 1, "the user annotation [is displayed] on the second map at *the* second map coordinates" (emphasis added). The Examiner appears to have given no weight to the antecedents of the claim terminology, which interrelate the elements. In that regard, Applicants point out that the Examiner must show that the applied references teach or suggest *all* claim limitations. *See* M.P.E.P. § 2143.03. The Examiner has not met that burden. Further, while the Examiner contends that conversion of vector data to raster data occurs in Hsu, nothing in Hsu discloses or suggests using georeferencing functions to locate a user annotation that is made on a first map at a corresponding location on a second map.

Still further, the Examiner has also not shown that Hsu teaches or suggests using a "georeferencing function of the first map" and using a "georeferencing function of the second map," as required by claim 1. While Hsu discloses that images are aligned

during preprocessing and, during that preprocessing, vector data is converted to image data, Applicants point out that the stated purpose of that conversion is "to correct geometric and spatial errors, to perform resolution matching, to zoom, rotate and scale (so as to align the separate images with one another). See col. 9, lines 31-37. Further, Hsu fails to disclose how that conversion occurs and, moreover, does not teach or suggest using a "georeferencing function of the first map" and using a "georeferencing function of the second map," as required by claim 1. Instead, according to Hsu, images are aligned so that the images share the same coordinate system, but Hsu does not teach using the claimed georeferencing functions.

In that regard, Applicants' specification teaches that "t]he preferred embodiment provides a system and method for coordinated manipulation of multiple displayed maps, even when the maps use different internal coordinate systems" (emphasis added). Specification at page 4, lines 9-12.[2] While the Examiner may not be required "to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit," the Examiner is required to interpret the claims in a reasonable manner in light of the specification. See MPEP § 2111. Had the Examiner interpreted claim 1 in light of the specification, the rejection would not stand because Hsu does not teach or suggest using a "georeferencing function of the first map" and using a "georeferencing function of the second map," as required by claim 1.

[2] In making reference to the specification, it is to be understood that Applicants are in no way intending to limit the scope of the claims to the exemplary embodiments described in the specification. Rather, Applicants expressly affirm that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation and applicable case law.

For at least the above reasons, Hsu does not teach all of the elements of claim 1. Furthermore, Hancock does not disclose or suggest the elements that are missing from Hsu. Hancock discloses "a system and method for providing services over a computer network" such as "information that is specific to the user's geographic location." See col. 2, lines 62-67. The Examiner applies Hancock, alleging that the reference "discloses allowing location addresses to be converted to other global addressing systems." See Office Action, page 4. Even if the Examiner's allegation is correct, which Applicants do not concede, converting an address from a location address format to a global address format does not teach or suggest claim 1. In particular, Hancock does not disclose or suggest a system for automatically annotating a second map when a first map is annotated including, among other things, "a map processing platform" to "receive a *user annotation* at a first location on the first map expressed by first map coordinates," and "display the *user annotation* on the second map at the second map coordinates" (emphasis added). Therefore, a combination of Hsu and Hancock does not teach or suggest all of the elements of claim 1 for at least this reason.

Furthermore, Hancock also does not disclose or suggest "convert[ing] from the first map coordinates to corresponding geographic coordinates using a georeferencing function of the first map" and "convert[ing] from the geographic coordinates to corresponding second map coordinates using a georeferencing function of the second map," as required by claim 1. In particular, the Examiner quotes Hancock at column 10, lines 48-65, which discusses converting a universal location address (ULA) to a World Geodetic System 1984 (WGS-84) address. See Office Action, pages 4-5. For example, the Hancock system uses a "reference point" that is located at the "approximate center"

of a city located in a district to convert from a ULA to a WGS-84 address. See col. 10, lines 53-54. Since the reference point has a known WGS-84 address, by using an offset of a ULA from that reference point, along with the district rotation and district scale, the ULA may be converted to a WGS-84 address. See col. 10, lines 57-62. Thus, Hancock teaches converting from an address format (i.e., ULA format) to another address format (i.e., WGS-94 format). However, converting addresses from one format to another does not teach or suggest claim 1. In particular, Hancock does not disclose or suggest "convert[ing] from the first map coordinates to corresponding geographic coordinates using a georeferencing function of the first map" and "convert[ing] from the geographic coordinates to corresponding second map coordinates using a georeferencing function of the second map," as required by claim 1. Accordingly, a combination of Hsu and Hancock does not teach or suggest all of the elements of claim 1 for at least this additional reason.

For at least the above reasons, Hsu and Hancock, whether taken individually or in combination, do not disclose or suggest all of the elements of claim 1. Accordingly, a *prima facie* case of obviousness has not been established. Therefore, the Examiner should withdraw the rejection of claim 1 under 35 U.S.C. § 103(a) and the rejection of dependent claims 2-15 and 21, which depend from claim 1.

Independent claims 18 and 20, while of a different scope from claim 1 and each other, include recitations similar to those of allowable claim 1. Accordingly, Hsu and Hancock, whether taken individually or in combination, do not disclose or suggest all of the elements of claims 18 and 20 for at least the above reasons. Accordingly, a *prima*

facie case of obviousness has not been established and the Examiner should also withdraw the rejection of claims 18 and 20 under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 27, 2006

By: _____
Anthony J. Lombardi
Reg. No. 53,232

Attachments: Copies of two IDS Forms PTO SB/08
Copies of two Decisions from the Office of Petitions

Applicants attach additional copies of the Forms PTO SB/08 from the IDSs of October 7, 2005 and December 12, 2005 for the Examiner's convenience.

Furthermore, Applicants note that a further IDS is being submitted concurrently with the present response. Applicants also request that the Examiner return an initialed copy of the Form PTO SB/08 indicating the Examiner's consideration of the documents cited therein.

II. DECLARATION

The Examiner alleged that the Declaration dated September 19, 2005 is defective. In particular, the Examiner contends that the Declaration is defective because Darin Wayne Higgins, a named inventor, has not signed the Declaration. Applicants respectfully traverse the Examiner's objection to the Declaration for the following reasons.

On September 19, 2005, Applicants filed a Request for Correction of Inventorship under 37 CFR § 1.48(a) and a Petition for Filing Declaration under 37 CFR § 1.183. The Request for Correction of Inventorship added John W. Howard to the present application and the Petition requested that a new Declaration be accepted on behalf of a non-signing inventor (i.e., Darrin Wayne Higgins), who refused to join in the present application. On February 6, 2006, the Office of Petitions sent (1) a Decision Granting Petition Under 37 CFR 1.48(a) accepting the change in inventorship and (2) a Decision Granting Petition Under 37 CFR § 1.183 accepting the Declaration on behalf of the nonsigning inventor.

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OFFICE OF PETITIONS

In re Application of	:	
John Willard Howard, Dan Martin Scott and	:	
Darin Wayne Higgins	:	DECISION GRANTING PETITION
Application No. 09/821,172	:	UNDER 37 CFR 1.48(a)
Filed: March 29, 2001	:	
Attorney Docket No. 03030.0002-03	:	

This is in response to the "Petition Under 37 CFR 1.48(a)," filed September 19, 2005.

The petition is granted.

The above-identified application was filed on March 29, 2001. Darin Wayne Higgins and Dan Martin Scott were named as joint inventors. On September 19, 2005, the instant petition under 37 CFR 1.48(a) was filed to correct the inventorship and add joint inventor John Willard Howard.

In view of the papers filed September 19, 2005, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by the addition of joint inventor John Willard Howard.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3228.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.

Reminder:
15-Allowance Follow Up: 3/7/05

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OFFICE OF PETITIONS

In re Application of
John Willard Howard, Dan Martin Scott and
Darin Wayne Higgins
Application No. 09/821,172
Filed: March 29, 2001
Attorney Docket No. 03030.0002-03

ON PETITION

This is in response to the "Petition Under 37 CFR 1.183," filed September 19, 2005, requesting waiver of the appropriate requirements under 37 CFR 1.48(a).

"Pursuant to 37 CFR 1.183, Applicants hereby petition that the attached Declaration/Power of Attorney, executed by John Willard Howard and Dan Martin Scott, be accepted by the U.S. Patent and Trademark Office on behalf of the above-named inventors and the non-signing inventor, Darin Wayne Higgins, who refuses to join in the application."

The petition is **granted**.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3228.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

DKP
2-8-04